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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,166	12/13/2000	Hiroji Fukui	M&M-033-USA-	2519

7590 05/22/2002

Townsend & Banta
1225 Eye Street NW Suite 500
Washington, DC 20005

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/22/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application N . 09/719,166	Applicant(s) FUKUI, HIROJI	
	Examiner Sanza L McClendon	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on February 28, 2002, the examiner has carefully considered the amendments. The examiner acknowledges the addition of claims 4-8.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamanna et al (5,554,664).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahoney et al (5,672,637) in view of Lamanna et al (5,554,664).

Response to Arguments

6. Applicant's arguments filed February 28, 2002 have been fully considered but they are not persuasive. The rejection of claims 1-3 as being anticipated by Lamanna et al stills stands—see above. Additionally, the rejection of claims 1-3 as being unpatentable over Mahoney et al in view of Lamanna et al still stands. Applicant appears to be relying on the limitation “low thermal catalytic activities in the approximate temperature range of 20 to 80 °C” as a

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property characteristic of the onium salt component in the composition of the instant invention. The examiner contends that applicant has not shown that the onium salts of Lamanna et al do not have a low thermal catalytic activity between the approximate temperature ranges of 20 to 80 °C. Examiner acknowledges the reference to column 9, lines 13-21, wherein applicant appears to be relying on the teaching that the onium salts of Lamanna et al have a metathesis reaction temperature range from about -80 °C to about 100 °C. However, the examiner disagrees with applicant's interpretation. The Examiner reads the teaching on column 9, lines 13-21 as teaching that skilled artisan can prepare an onium salt prior to use in the composition by an anion exchange reaction of a metathesis reaction by reacting an initiator or catalyst free acids or salt that contain conventional counter anions; which is carried out at temperatures between about -80 °C to about 100 °C. This teaching does not, in the examiner interpretation, mean that the onium salts taught by Lamanna have thermal catalytic activity in the temperature range of about -80 °C to about 100 °C in the absence of evidence and/or arguments to the contrary. In addition, the examiner has shifted the burden back to applicant to provide evidence that the onium salts taught by Lamanna et al do not have the required thermal catalytic activity.

7. Applicant's arguments with respect to claims 4 and 7-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claims 4 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The teaching of a photosensitive onium salt having a low thermal catalytic activities ... excluding an onium salt having fluorocarbon anion which is an (a) imide anion having two highly fluorinated alkyl sulfonyl, ... or (b) a methide anion having three highly substituted alkyl sulfonyl ... and combinations thereof is not taught in the specification of the instant patent application. With regards to the excluded components, negative limitations recited in claims, which do not appear in the specification as filed, introduced new concepts and violate description requirement of 35 USC 112—see *Ex parte Grasselli* or *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). Applicant teaches onium salts that include but are not limited to aromatic diazonium salts, aromatic iodonium salts, aromatic sulfonium salts, and the like—see page 6, lines 10-12. The examiner suggests using the teachings in the specification so that negative limitations are avoided in the claimed subject matter.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

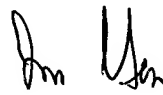
Sanza L McClendon

Examiner

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SMc

May 20, 2002


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700